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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,916	05/30/2001	August Geiger	051176-5036	6036
9629	7590	03/29/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			JENKINS, KIMBERLY YVETTE	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,916

Applicant(s)

GEIGER ET AL.

Examiner

Kimberly Jenkins

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. The arguments of Application No. 09/856916 filed on November 23, 2004 regarding primary reference Watanukie et al. (US 6389856) as not qualifying as prior art because the filing date was filed after the foreign priority date of the instant have been taken into consideration and are persuasive. The rejection has been withdrawn; however upon further consideration, a new ground(s) of rejection is made in view of Wake et al. (EP 0464278) in view of Kleefeldt et al. (US 4837567).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 8-9 are rejected under 35 U.S.C. 103 (a) as being unpatentable under Wake et al. (EP 0464278) in view of Kleefeldt et al. (US 4837567).

Regarding claims 1 and 2, Wake, who teaches a burglar-proof device for a vehicle, expressly discloses a holder 8 for the key 7 (col. 1, lines 45-38), wherein the holder 8 comprises a switching elements 1/11 therein (col. 1, lines 48-51 and col. 2, lines 42-47). In addition, Wake discloses a coded operation within the lock 1 after positive evaluation between the key and the processing unit in order to actuate the holder 8 (col. 1, line 57-col.1 2, line 8). Wake discloses blocking elements 9 (movable obstructions) that execute adjustments upon the introduction of the key 7 into the holder (col. 3, lines 11-29). Wake also discloses the switching member 11 at the other end of the blocking member 9 (col. 3, lines 36-49 and Fig. 4). Wake discloses a magnetic key; however Wake does not expressly disclose the key as being an electronic key.

However, Kleefeldt, who teaches a security system for vehicles, expressively discloses the security as being in the embodiment of an electronic key 6 that fit into a holder 7 (barrel) wherein the proper code must be provided in order to start the engine (col. 5, lines 11-19). The electronic-coded key is utilized for the system as a means to prohibit auto theft. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the magnetic key of Wake to be replaced by the electronic key of Kleefeldt, because both key types cannot be duplicated as a means to prevent unauthorized users from attempting to steal the vehicle.

Regarding claim 3, Wake discloses the blocking elements 9 as being actuated by a spring force in a groove within the inner tubular member of the holder 8 (col. 3, lines 30-42 and col. 4, lines 40-49).

Regarding claim 4, Wake discloses the extension of the key acting on the blocking element 9 to bring about adjustments (col. 7, line 55-col. 8, line 20).

Regarding claim 5, Wake discloses a lever 11b betwixt the blocking element 9 and the switching element 11 in that which the adjustment of the blocking element 9 moves in order to exert a switching action on the switching element 11 (Fig. 18 and col. 8, lines 6-29).

Regarding claim 8, Wake discloses the holder 8 as being designed to move rotationally by means of the key 7 (col. 2, line 57-col. 3, line 1 and lines 16-21 and Fig. 2). The inner tubular 5 member of the holder 8 rotates (via a rotor) and the blocking elements 9 are mounted on the rotor (rotation portion, Fig. 2).

Regarding claim 9, Wake discloses holder 8 as comprising a blocking element 9 (col. 3, lines 11-14); however, Wake does not disclose the blocking element as a means to prevent the removal of the electronic key (electronic key limitation has been mentioned above regarding claim 1).

However, Kleefeldt discloses the blocking element 107 within the holder 7 as being a means to prevent the key 6 from being removed (col. 5, line 67-col. 6, line 10). Therefore, it would have been obvious at the time the invention was made to have the blocking elements to hinder one from removing

the key as suggested in Kleefeldt, because Wake discloses the blocking elements within the key holder, whereas Kleefeldt discloses the prevention of key removal as a means to prevent one from taking the key.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wake in view of Kleefeldt (hereinafter Wake) in further view of Mullin et al (GB 2169651A).

Regarding claim 6, Wake discloses a spring-loaded blocking element 9 (col. 3, lines 16-21); however, Wake does not expressly disclose a cam on top of the blocking element 9.

On the other hand, Mullin, who teaches a locking device with an encoded key, discloses that the cam member (fig. 1, 6) slides within a groove. The cam member (6) is to operate the ignition switch of a vehicle (col. 1, lines 63-65). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention was made to supply the cam of Mullin into the holder of Wake, because Wake discloses the blocking elements, whereas Mullin discloses a cam member, which is a convention component of a lock.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wake in view of Kleefeldt (hereinafter Wake) in further view of Neuhalfen (US 5974661).

Regarding claim 7, Wake teaches that the switch element 11 is of the push-button type (col. 6, lines 36-47); however, Wake does not teach that the switch 11 as being of surface mounted device (SMD) technology on a printed-circuit board (PC boards).

Neuhalfen, who teaches electronic components within a surface mounted device, discloses that SMD is designed to protect electronic components from electrostatic discharge (ESD) (Abstract, lines 4-6). In addition, Neuhalfen also teaches that PC boards are found in electronic devices of all kinds (col. 1, 25-29). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention was made to include SMD technology in the ignition lock of Wake as evident by Neuhalfen, because Wake suggests that the electronic locking device is mounted within a vehicle (col. 1, lines 45-49), whereas Neuhalfen discloses the SMD in order to prevent any damage to the electronic device, such as an electronic lock.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Hamilton whose telephone number is 703.305.8975. The examiner can normally be reached from Monday - Friday between the hours of 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703.305.4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

Kimberly Jenkins
Examiner
Art Unit 2635
17 March 2005

KYJ

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
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